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10/021,129	12/12/2001	Yeong-Taeg Kim	SAM2.0004	2469

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EXAMINER
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YIMAM, HARUN M

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/021,129

Applicant(s)

KIM, YEONG-TAEG

Examiner

Harun M. Yimam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/18/2006 has been entered.

### ***Response to Arguments***

2. Although a new ground of rejection has been used to address additional limitations that have been added to **claim 1, 9, 12 and 14**, a response is considered necessary for several of applicant's arguments since applicants make arguments that need to be addressed and also since references Zigmond (6698020), Kim (US 2002/0010927), Gupta (20040073947) and Dimitrova (6469749) will continue to be used to meet several claimed limitations.

3. In response to applicant's argument (page 9, 2<sup>nd</sup> paragraph) that Zigmond does not specifically disclose a digital television receiver performing a digital TV function, applicant should note that Zigmond does disclose a digital television receiver (fig. 3, el. 60; col. 7, lines 37-67) performing a Digital TV function (selecting and displaying advertisements—col. 7, lines 25-49). Note: column 7, lines 25-67; digital data stream; WebTV.

4. In response to applicant's argument (page 9, 2<sup>nd</sup> paragraph) that Zigmond does not specifically disclose "storing a plurality of advertisement messages in a storage device", applicant should note that Zigmond indeed supports the above. Note: (fig. 4, 5, [15, 17-34]; [8, 1-11] wherein the advertisements are effectively cached at a point in time).

5. In response to applicant's argument (page 9, 2<sup>nd</sup> paragraph) that element 62 in fig. 4 of Zigmond is an ad source and not a storage device, applicants should note that said adds are received and stored by element 62 for later distribution. The claim calls for "storing a plurality of advertisement messages in a storage device for later access" and Zigmond explicitly discloses said limitation (fig. 5, elements 83 and 86; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11).

6. In response to applicant's argument (page 9, 2<sup>nd</sup> paragraph) that element 66 in Zigmond is simply a programming source and does not disclose using the digital television receiver to receive video from the provider, applicant should note that Zigmond explicitly discloses that the digital television receiver (fig. 3, el. 60; col. 7, lines 37-67) receives video programming feed 52 from the content provider 50 (fig. 3, el. 66; col. 8, lines 29-38; col. 7, lines 1-25).

7. In response to applicant's argument (page 10, 2<sup>nd</sup> paragraph) that element 58 in Zigmond is a display monitor not a receiver for subsequent output, applicant should note that the Examiner is not stating that the display monitor is a receiver and Zigmond clearly discloses outputting the plurality of the advertisement messages and the received video data received by the digital television receiver on a display monitor (fig. 3, el. 58; col. 8, lines 29-38).

8. In response to applicant's argument (page 10, 2<sup>nd</sup> paragraph) that Zigmond does not disclose outputting the plurality of the advertisement messages and the received video data with the digital television receiver, argument is addressed above and in the rejection below.

9. In response to applicant's argument (page 10, 2<sup>nd</sup> paragraph) that if a predetermined number of the plurality of the advertisement messages have been

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output, then the digital TV function is disabled such that unlike Zigmond regular video programming is disabled, applicant should note that el. 61 counts the number of times a viewer has seen a selected ad. Once the ad has been displayed the desired number of times, display of the advertisement to the viewer is blocked col. 13, lines 40-47 and in this case, disable the display of the advertisement to the viewer—col. 13, lines 40-47.

10. The remaining arguments are already addressed above and/or in the rejection below.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1 – 4 and 6 – 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond (U.S. 6,698,020).

Considering claim 1, Zigmond discloses a method for operating a digital television receiver, which comprises:

providing a digital television receiver (fig. 3, el. 60; col. 7, lines 37-67) performing a Digital TV function (selecting and displaying advertisements—col. 7, lines 25-49) including receiving and outputting information (receiving a programming feed 52 and outputting it for display—col. 7, lines 25-49);

storing a plurality of advertisement messages in a storage device (fig. 5, elements 83 and 86; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11);

subsequent to storing the plurality of the advertisement messages, using the digital television receiver to receive video data from a digital television service provider for subsequent output with the advertisement using the Digital TV function of the digital television receiver (fig. 3, el. 66; col. 8, lines 29-38; col. 7, lines 1-25);

accessing the stored advertisement messages in the storage device (col. 15, lines 17-34);

with the digital television receiver, arranging (pre-screen and/or pre-filter—col. 15, lines 17-34) and outputting the plurality of the advertisement messages and the received video data (fig. 3, el. 58; col. 8, lines 29-38);

maintaining a count of the number of the plurality of the advertisement messages that has been output by the digital television receiver (col. 13, lines 40-47); and

if a predetermined number of the plurality of the advertisement messages have been output by the digital television receiver (el. 61 counts the number of times a viewer has seen a selected ad. Once the ad has been displayed the desired number of times,

display of the advertisement to the viewer is blocked col. 13, lines 40-47), then disabling the digital TV function (in this case, disable the display of the advertisement to the viewer—col. 13, lines 40-47) of the digital television receiver.

As to claim 2, Zigmond discloses that after the digital TV function has been disabled, such that video data from the digital television service provider are no longer output, storing a new set of the plurality of advertisement messages in the storage device (advertisements continue to be transmitted col. 8, lines 29-39, and new advertisements are stored after an advertisement has reached its desired number viewing times col. 13, lines 40-47); and subsequently enabling the digital TV function of the digital television receiver (ads that have not reached the desired number viewing counts proceed to be displayed col. 8, lines 29-39).

With regards to claim 3, Zigmond discloses performing the step of storing the new set of the plurality of the advertisement messages in the storage device by downloading the new set of the plurality of the advertisement messages from a network (fig. 8, el. 64; col. 8, lines 29-37).

Regarding claim 4, Zigmond discloses setting the predetermined number such that all of the plurality of the advertisement messages that were stored will be output (advertisers pay for a guaranteed number of exposures col. 14, lines 49-58).



Considering claim 6, Zigmond discloses providing the storage device as a component of the digital television receiver (fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11).

As to claim 7, Zigmond discloses performing the step of storing the plurality of the advertisement messages by downloading the plurality of the advertisement messages from a network (fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11).

With regards to claim 8, Zigmond discloses receiving additional video data from the digital television service provider; with the digital television receiver, outputting the additional video data without outputting the plurality of the advertisement messages (col. 18, line 38 to col. 19, line 9); and limiting a duration that the step of outputting the additional video without outputting the plurality of the advertisement messages can be performed (information relating to program description that appear in the feed. Since programs change, topics change and appear for a duration; col. 18, line 38 to col. 19, line 9).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 5, 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond (U.S. 6,698,020) in view of Kim (US 2002/0010927).

Regarding claim 5, Zigmond teaches outputting the plurality of advertisement messages that were stored to be output (col. 15, lines 17-34; col. 18, lines 29-63). Zigmond fails to specifically teach a banner and performing the outputting step such that the plurality of advertisement messages that were stored are output as banner as advertisement messages together with the received video data.

In an analogous art, Kim discloses a system of displaying the program signal with the banner [0076].

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Zigmond's system to teach performing the outputting step such that

the plurality of the advertisement messages that were stored are output as banner advertisement messages together with the received video data, as taught by Kim, so as to not frustrate users who wish to view their chosen program from beginning to end without interruption.

As to claim 12, Zigmond discloses a digital television receiver, comprising:

a receiving module (home entertainment system/household 56 in figure 3—column 6, lines 30-47) for receiving video bit streams (video programming feed 52 in figure 3) from a service provider (50 in figure 3 and column 7, lines 1-34);

a program selector for selecting a program (inherently disclosed in column 7, lines 26-49);

a video decoder for decoding received video bit streams of a selected program to obtain decoded video bit streams of the selected program (col. 6, lines 40-47);

an banner storage device (fig. 5, el. 86) for storing data representing advertisement messages and thereby obtaining stored data (fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11);

an banner rendering unit for decoding and rendering selected ones of the stored data to obtain rendered data (fig. 5, el. 84, 86, 83; [15, 16-34]; [12, 33-43]);

a counter module that is configured to maintain the number of advertisement messages read out from said banner storage device (el. 61 of figure 4 counts the number of times a viewer has seen a selected ad—col. 13, lines 40-47);

an ad manager unit for reading out the stored data from said banner storage device and for providing the stored data to said banner rendering unit, said banner manager unit checking the counter module and generating a disable signal when a predetermined number of the advertisement messages, represented by the stored data, have been read out from the banner storage device (el. 61 counts the number of times a viewer has seen a selected ad. Once the ad has been displayed the desired number of times, display of the advertisement to the viewer is blocked col. 13, lines 40-47; display of the advertisement to the viewer is blocked col. 13, lines 40-47); and

Zigmond fails to specifically teach processing banner and a video reconstruction unit for arranging and combining the rendered data with the decoded video bit streams of the selected program to obtain a combined video output signal that includes information representing the selected program.

In an analogous art, Kim discloses processing a banner ([0076]) and a system of a video reconstruction unit for combining the rendered data with the decoded video bit streams of the selected program to obtain a combined video output signal that includes information representing the selected program (fig. 8, el. 807; [0076]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Zigmond's system to include processing banner and a video reconstruction unit for combining the rendered data with the decoded video bit streams of the selected program to obtain a combined video output signal that includes

information representing the selected program, as taught by Kim, so as to not frustrate users who wish to view their chosen program from beginning to end without interruption. Kim discloses: an output terminal connected to said video reconstruction unit for receiving the combined video output signal and for outputting the combined video output signal ([0076]).

As to claim 13, Zigmond discloses a system control unit for receiving the disable signal and, in response thereto, for prohibiting said output terminal from receiving the information representing the selected program (el. 61 counts the number of times a viewer has seen a selected ad. Once the ad has been displayed the desired number of times, display of the advertisement to the viewer is blocked col. 13, lines 40-47; display of the advertisement to the viewer is blocked col. 13, lines 40-47).

As to claim 15, a network adapter (inherently inside the STB) for downloading the stored data into said banner storage device from an external network (fig. 7, el. 64; col. 8, lines 29-37; fig. 5, el. 84; col. 15, lines 17-34; fig. 4, el. 62, col. 8, lines 1-11).

15. Claims 9 – 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond (6698020) in view of Gupta (20040073947) and further in view of Dimitrova (6469749).

As to claims 9 and 10, Zigmond fails to specifically teach initializing a counter to a predetermined value; incrementing the counter by an amount corresponding to an amount of time that the step of outputting the plurality of the advertisement messages and the received video data is being performed; decrementing the counter by an amount corresponding to an amount of time that the step of outputting the additional video without outputting the plurality of the advertisement messages is being performed; and when the counter reaches the predetermined value, discontinuing the step of outputting the additional video without outputting the plurality of the advertisement messages.

In an analogous art, Gupta discloses:

initializing a counter to a predetermined value (counter resets to zero [0074]);  
incrementing the counter by an amount corresponding to an amount of time that the step of outputting the plurality of the advertisement messages and the received video data is being performed ([0074]; [0078]; [0085]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Zigmond's system to teach performing the limiting step by: initializing a counter to a predetermined value; incrementing the counter by an amount corresponding to an amount of time that the step of outputting the plurality of the advertisement messages and the received video data is being performed, as taught by Gupta, so as to allow monitoring of media and determine which information to output.

Zigmond in view of Kim and in further view of Gupta fail to specifically disclose: decrementing the counter by an amount corresponding to an amount of time; and when the counter reaches the predetermined value, discontinuing the step of outputting the advertisement messages.

In an analogous art, Dimitrova discloses a system of decrementing the counter by an amount corresponding to an amount of time; and when the counter reaches the predetermined value, discontinuing outputting the advertisement messages (the commercial is eventually "forgotten" by the system; col. 7, lines 8-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Zigmond in view of Gupta system to teach decrementing the counter by an amount corresponding to an amount of time; and when the counter reaches the predetermined value, discontinuing outputting the advertisement messages, as taught by Dimitrova, so as to allow the system to determine how long to allow the commercial to air.

As to claim 11, Gupta discloses providing the counter as a component of the digital television receiver (fig. 2, el. 180; [0074]).

16. Claims 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over

Zigmond (6698020) in view of Kim (20020010927), as applied to claim 12 above, and further in view of Dimitrova (6469749).

As to claim 14, Zigmond discloses that said video reconstruction unit is outputting the information representing the selected program without the rendered data (col. 18, line 38 to col. 19, line 9). Kim discloses that the rendered data is combined with the decoded video bit streams of the selected program in said video reconstruction unit ([0076]) said video reconstruction unit also configured to selectively output the information representing the selected program without the rendered data (fig. 8,el. 807; [0076]).

Zigmond and Kim fail to teach a counter having a value that is incremented.

In an analogous art, Gupta discloses a system of a counter having a value that is incremented ([0074]; [0078]; [0085]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system Zigmond and Kim to a counter having a value that is incremented, as taught by Gupta, so as to allow monitoring of media and determine which information to output.

Zigmond, Kim and Gupta fail to specifically disclose that said value of said counter being decremented in proportion to an amount of time during and when the



value of said counter reaches a predetermined lower limit value, said video reconstruction unit being prohibited from outputting the information.

In an analogous art, Dimitrova discloses a system said value of said counter being decremented in proportion to an amount of time during and when the value of said counter reaches a predetermined lower limit value, said video reconstruction unit being prohibited from outputting the information (the commercial is eventually "forgotten" by the system; col. 7, lines 8-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Zigmond in view of Gupta system to teach decrementing the counter by an amount corresponding to an amount of time; and when the counter reaches the predetermined value, discontinuing outputting the advertisement messages, as taught by Dimitrova, so as to allow the system to determine how long to allow the commercial to air.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harun M. Yimam whose telephone number is 571-272-7260. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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HMY

A handwritten signature in dark ink, appearing to read 'J. Miller', with a long horizontal flourish extending to the right.

**JOHN MILLER**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**